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**THIS DISPOSITION IS NOT
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OF THE TTAB**

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Paper No. 16
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Golden Too, Inc.**

Serial No. 76/201,648

Charles P. LaPolla and Mary G. Fontenot of Ostrolenk, Faber, Gerb & Soffen, LLP for **Golden Too, Inc.**

Michael W. Baird, Trademark Examining Attorney, Law Office 109
(Ronald R. Sussman, Managing Attorney).

Before **Hohein, Hairston and Bottorff**, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Golden Too, Inc. has filed an application to register the mark "GOLDEN TOO" for "clothing, namely, shirts, pants, skirts, vests, jackets and suits."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "GOLDEN" and design, which is registered as reproduced below

¹ Ser. No. 76/201,648, filed on January 30, 2001, which is based on an allegation of a bona fide intention to use the mark in commerce.



for a "clothing line, namely, blouses, ladies['] pants and skirt suits, jumpsuits, shorts, slacks, blazers, bathing suits, belts, hats and ski suits,"² as to be likely to cause confusion, or mistake or to deceive.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³

Turning first to consideration of the respective goods, it is clear that applicant's items of clothing are identical in part (e.g., ladies' pants and skirt suits) and are otherwise closely related to the products in registrant's clothing line.

² Reg. No. 2,209,122, issued on December 8, 1998, which sets forth a date of first use anywhere and in commerce of November 15, 1997.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Suffice it to say that both applicant and registrant are marketing the kinds of wearing apparel which would be sold to the same classes of consumers (e.g., women and teenage girls) through the same channels of trade (e.g., clothing stores, department stores, mass merchandisers, and boutiques). Although applicant argues in its initial brief that purchasers of clothing "are somewhat sophisticated" in that they "are usually quite particular over the quality and nature of the goods being sold," the substantial majority of customers for wearing apparel plainly are not highly discriminating professional buyers but are instead simply ordinary consumers who typically would exercise nothing more than reasonable care in their selection and purchasing of wearing apparel.⁴ For ordinary consumers, purchasing decisions with respect to items of clothing may frequently involve or be based on such impulsive considerations as matters of style and comfort and are not dependent solely upon strictly pragmatic factors like product value and durability. In short, not only are the classes of customers the same, but the conditions under which applicant's and registrant's goods are offered for sale are such that, if marketed under the same or similar marks, confusion as to their source or sponsorship is likely to occur.

Turning, therefore, to consideration of the respective marks, applicant contends in its initial brief that, "[b]y

⁴ As the Examining Attorney acknowledges in his brief, while "there is a segment of the population who can be considered sophisticated purchasers of clothing," "it is clear that a significantly larger segment of the purchasing public is 'unsophisticated'" since, "with the possible exception of radical naturalists, every resident of the United States wears clothing."

failing to give appropriate consideration to the term TOO in Applicant's mark and the distinct design element in the cited mark, the Examining Attorney has failed to analyze the marks in their entirety." Specifically, applicant argues that:

Looked upon in its entirety, Applicant's mark GOLDEN TOO has a different appearance and pronunciation from the cited GOLDEN And Design mark. As a result of the additional term TOO in Applicant's mark and the distinguishing distinctive design in the cited registration, a consumer, when encountering these marks in the marketplace, would not only perceive the different appearances of the marks, but would also pronounce Applicant's mark in a different manner from the cited registration.

Applicant also asserts that the Examining Attorney failed to take into account the evidence it presented to show that registrant's "GOLDEN" and design mark is weak and, as such, is entitled only to a narrow scope of protection. In particular, applicant states in its initial brief that it is well settled that "a finding of likelihood of confusion cannot be predicated upon the presence in each mark of a weak or suggestive term, when the remaining portions of that mark differ in appearance, sound and/or meaning."

As support for its assertion that "the similarity of the term GOLDEN must be de-emphasized due to the common and weak nature" thereof, applicant relies upon copies which it made of record of 11 "co-existing federal registrations [for marks] which utilize the word GOLDEN in connection with clothing" as well as copies it placed in the record of "numerous other [registrations for] trademarks incorporating the term GOLDEN for items in

International Class 25."⁵ Applicant urges, in view thereof, that:

The foregoing registrations show that use of the GOLDEN designation, with another word or words, is very common. Such widespread use, the majority of which is for goods directly related to those used under Applicant's mark and the cited registration, indicates that the cited GOLDEN And Design mark is weak and co-exists in a crowded field of "Golden" marks with regard to goods sold in International Class 25. As such, the cited registration is not entitled to strong trademark protection.

Furthermore, according to applicant, "[i]t is particularly noteworthy that many of the co-existing marks incorporating the term GOLDEN ... contain only single additional words which are certainly no more distinctive or distinguishing than the term TOO, e.g., A.M., SMILE, BAY, HORDE, WEST, etc." Applicant insists that, likewise, the differences between the marks at issue herein "are significant enough to avoid a likelihood of confusion."

The Examining Attorney, on the other hand, correctly points out that "the mere existence of third-party registrations does not constitute evidence of the use of the marks shown therein, or that the public is familiar [with] the marks" and is therefore able to distinguish the source thereof based upon the differences in such marks. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB

⁵ The latter, applicant indicates, include "at least seventy registered marks, one published mark, and at least sixty canceled and expired registrations--all of which currently co-exist on the Principal Register or co-existed on the Principal Register at various times."

1983); and *National Aeronautics & Space Administration v. Record Chemical Co., Inc.*, 185 USPQ 563, 567 (TTAB 1975). Nonetheless, as applicant realizes in its reply brief, such registrations may properly be given some weight to show the meaning of a mark in the same way that dictionary definitions would be so used. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). In view thereof, and citing the definition attached to its reply brief from The American Heritage Dictionary of the English Language (4th ed. 2000) which shows that "the term GOLDEN can have the meanings of 'favorable,' 'precious,' 'excellent,' 'gifted' and 'promising,'" ⁶ applicant maintains that "the weight attached to such a common and laudatory term should be discounted when considering the issue of likelihood of confusion" because consumers will rely instead on the presence of other elements to distinguish among marks containing the term "GOLDEN."

Applicant, in consequence of the above, argues in its reply brief that, as assertedly indicated in the file wrapper for the cited registration, "the design element is the representation

⁶ Specifically, such term is defined as an adjective meaning "1. Of, relating to, made of, or containing gold. 2a. Having the color of gold or a yellow color suggestive of gold. b. Lustrous; radiant: *the golden sun*. c. Suggestive of gold, as in richness or splendor: *a golden voice*. 3. Of the greatest value or importance; precious. 4. Marked by peace, prosperity, and often creativeness: *a golden era*. 5. Very favorable or advantageous; excellent: *a golden opportunity*. 6. Having a promising future; seemingly assured of success: *a golden generation*. 7. Of or relating to a 50th anniversary." We have considered such definition inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

of an egg" and thus "the connotation of the cited mark is 'GOLDEN EGG.'" Applicant further argues that "[e]ven without considering ... the file wrapper for the cited mark, it is obvious that the design element of the [registrant's] mark is an egg, thus connoting 'GOLDEN EGG.'" By contrast, applicant states, "the additional word element in Applicant's mark is TOO[,] which does not bring to mind an egg" and thereby serves to distinguish its "GOLDEN TOO" mark from registrant's "GOLDEN" and design mark. Specifically, besides the absence of an egg design element from its mark, applicant urges that:

The Examining Attorney also unduly discounts the distinguishing differences created by the additional term TOO in Applicant's mark. The term TOO does not merely convey more of what precedes the term. Rather the term TOO has a certain ambiguity capable of alternative meanings. Some persons may view the term TOO in a manner equivalent to the number "2." For those who view the word TOO as meaning "more" or "also," there is ambiguity and alternative possibilities as to what is being qualified by the term TOO. For example, especially due to the multiple and laudatory connotations associated with the term GOLDEN, some persons may view the Applicant's mark as meaning TOO COOL, or TOO STYLISH, TOO BEAUTIFUL, TOO FASHIONABLE, or IN TOO GOOD OF OR FAVORABLE A POSITION.

Applicant concludes, in its reply, that there is no likelihood of confusion from the contemporaneous use of the respective marks in connection with articles of clothing because, due to the weakness of the term "GOLDEN," such term "is not the primary element of each mark and the overall elements of each mark create a different commercial impression in the minds of consumers."

We agree with the Examining Attorney, however, that when considered in their entirety, the marks at issue are so substantially similar in sound, appearance, connotation and commercial impression that the contemporaneous use thereof in connection with identical and closely related items of clothing is likely to cause confusion as to the origin or affiliation of such products. Specifically, due to the shared term "GOLDEN," which forms the dominant element of each mark (for the reasons discussed below), it is obvious that applicant's "GOLDEN TOO" mark and registrant's "GOLDEN" and design mark are substantially similar both aurally and visually. As to the former, registrant's mark would most likely be pronounced simply as "GOLDEN," rather than "GOLDEN EGG" as contended by applicant in its reply brief, especially since there is nothing about any of the items in registrant's line of clothing which would tend to suggest that, when its mark is used in connection therewith, the mark is meant by registrant to be pronounced as if it were the words "GOLDEN EGG" or that consumers would so regard it. Thus, while concededly such design is recognizable upon reflection as an egg design, there is nothing in the nature of the associated goods or otherwise which indicates that at first glance consumers would view or understand the design element in registrant's mark as forming anything other than a background design or vehicle for the display of the word "GOLDEN."

While the same, obviously, is likewise true as to the appearance of registrant's mark, it remains the case that the word "GOLDEN" appears as a prominent, if not the dominant,

element thereof. Consequently, irrespective of whether consumers would regard the design element in such mark as merely a display for the word "GOLDEN" or would see the design as that of an egg, it must still be kept in mind, as alluded to by the Examining Attorney, that because applicant seeks to register its "GOLDEN TOO" mark in typed form, the display thereof could include the same stylized manner of lettering as that utilized by registrant for the word "GOLDEN" in its mark. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in typed format is not limited to the depiction thereof in any special form]; and INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word] could be depicted"]. Thus, in addition to sounding substantially alike, applicant's and registrant's marks are substantially similar in overall appearance.

Moreover, due to the dominance in each mark of the term "GOLDEN, the marks at issue are also substantially similar in connotation and overall commercial impression. The Examining Attorney, citing the definition attached to his brief from The American Heritage Dictionary of the English Language (3rd ed. 1992) which defines the word "TOO" as an adverb meaning, *inter alia*, "1. In addition; also: *He's coming along too.* 2. More than enough; excessively: *She worries too much.* 4. Very; extremely; immensely: *He's only too willing to be of*

service. 5. *Informal*. Indeed; so: *You will too do it!*,"⁷ persuasively contends in this regard that the dominant element of applicant's mark is the word "GOLDEN." As the Examining Attorney states in his brief: "The term GOLDEN does not modify the term TOO; instead, the word TOO merely emphasizes that the primary term [in applicant's mark] is GOLDEN." We also concur with the Examining Attorney that the dominant element of registrant's mark is the term "GOLDEN" since, as he correctly points out: "When a mark consists of a word portion and a design portion, [it is] the word portion [which] is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods" See, e.g., *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Such is particularly the case where, as here, the design element in registrant's mark principally serves, especially at first glance, as a background or vehicle for the display of the word "GOLDEN."

In consequence of the above, we agree with the Examining Attorney that consumers of clothing who are familiar or acquainted with registrant's mark "GOLDEN" and design "are likely to come to the conclusion that Applicant's goods are GOLDEN-brand 'also'" inasmuch as the word "TOO" in applicant's mark "GOLDEN TOO" is most likely to signify that its goods are, in addition, "GOLDEN" in some manner. The same is similarly the case even if the word "TOO" in applicant's mark is regarded by some purchasers as meaning, instead of "also," either "excessively" or

⁷ Judicial notice has been taken thereof as implicitly requested by the Examining Attorney.

"extremely" or as denoting "indeed" or "so." Such would still be the case among customers who notice the design element in registrant's mark as those purchasers would be likely to regard applicant's "GOLDEN TOO" mark as designating a new or additional line of clothing items from the same source as the line of clothing marketed under registrant's "GOLDEN" and design mark.

Admittedly, the third-party registrations made of record, as well as the dictionary definition of the word "GOLDEN," serve to demonstrate that such word has been frequently incorporated into marks for clothing because of its laudatory significance. The fact that such word is therefore weak in terms of its trademark significance does not mean, however, that registrant's mark is entitled to protection only against the same or a virtually identical mark. It is well established, instead, that even a weak mark is entitled to protection against the registration of the same or a substantially similar mark for identical and/or closely related goods. See, e.g., *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978); and *In re Textron Inc.*, 180 USPQ 341 (TTAB 1973), *citing* *Eastern Industries, Inc. v. Waterous Co.*, 289 F.2d 952, 129 USPQ 422, 424 (CCPA 1961). Such is the case herein.

In particular, the third-party registrations referenced by applicant are entitled to little weight on the question of likelihood of confusion. See, e.g., *In re Hub Distributing, Inc.*, supra at 285. Such registrations, as previously indicated, are not evidence that the marks shown therein are in use or that the public is familiar with them and, in any event, the existence

on the register of arguably similar marks cannot aid an applicant in its effort to register another mark which so resembles a registered mark as to be likely to cause confusion. See, e.g., AMF Inc. v. American Leisure Products, Inc., supra; and Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967). In this case, none of the marks relied upon by applicant is as substantially similar to applicant's mark as is registrant's mark. Instead, as the Examining Attorney cogently argues:

The other registrations referenced by Applicant can be easily distinguished: in all the referenced registrations, the term GOLDEN is used as an adjective or adverb, modifying additional wording in the respective marks ("GOLDEN SMILE," "GOLDEN BAY," "GOLDEN HORDE," etc.) The [cited] registered mark, on the other hand, is composed solely of the term GOLDEN [as the literal element thereof]. It [thus] lacks any additional wording and "GOLDEN" does not modify any other term.

Consequently, unlike the marks which are the subjects of the third-party registrations relied upon by applicant, the Examining Attorney is correct that the marks at issue herein *"have no additional distinctive wording which may serve as a basis to distinguish the marks"* (emphasis in original). As a result, the Examining Attorney properly notes that, while "the registrations presented by Applicant clearly refer to golden things, the marks in the cited registration and the application use the term GOLDEN in a more nebulous manner, evoking the *idea* of gold, as opposed to any one specific object" (emphasis in original). Therefore, although the word "GOLDEN" is weak in view of its laudatory significance, we share the Examining Attorney's

view that it is not lacking in distinctiveness and that the addition thereto of the word "TOO" to form applicant's "GOLDEN TOO" mark does not create either a new or sufficiently different commercial impression from registrant's "GOLDEN" and design mark as to preclude a likelihood of confusion when such marks are used in connection with the same and closely related items of clothing. See, e.g., BAF Industries v. Pro-Specialties, Inc., 206 USPQ 166, 175-76 (TTAB 1980) [while dictionary and third-party registration evidence reflected that term "PRO," as a recognized abbreviation for the word "professional," had a laudatory connotation such that marks which consisted of or included the term consequently were weak marks which were entitled to only a narrow scope of protection, the addition of the term "SPECIALTIES" to form the mark "PRO-SPECIALTIES" for use in connection with a variety of detergents, cleaners, polishes and waxes was insufficient to distinguish the mark from, and avoid a likelihood of confusion with, various "PRO" marks for a variety of products including waxes, polishes and cleaners].

We accordingly conclude that purchasers and prospective customers, familiar or acquainted with registrant's "GOLDEN" and design mark for a "clothing line, namely, blouses, ladies['] pants and skirt suits, jumpsuits, shorts, slacks, blazers, bathing suits, belts, hats and ski suits," could reasonably assume, upon encountering applicant's substantially similar "GOLDEN TOO" mark for "clothing, namely, shirts, pants, skirts, vests, jackets and suits.," that such identical and otherwise closely related items of apparel emanate from, or are sponsored

by or affiliated with, the same source. Furthermore, to the extent that we may nevertheless entertain any doubt as to this conclusion, we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal under Section 2(d) is affirmed.